



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/424,544	11/24/1999	MASUMITSU INO	SON-1582/SUG	8128

7590 11/26/2008  
RONALD P KANANEN  
RADER FISHMAN & GRAUER  
THE LION BUILDING  
1233 20TH STREET NW SUITE 501  
WASHINGTON, DC 20036

EXAMINER
----------

ART UNIT	PAPER NUMBER
----------	--------------

DATE MAILED: 11/26/2008

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Notification of Non-Compliant Appeal Brief (37 CFR 41.37)</b>	<b>Application No.</b> 09/424,544	<b>Applicant(s)</b> INO ET AL.	
	<b>Examiner</b> Jeff Piziali	<b>Art Unit</b> 2629	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--**

The Appeal Brief filed on 03 September 2008 is defective for failure to comply with one or more provisions of 37 CFR 41.37.

To avoid dismissal of the appeal, applicant must file an amended brief or other appropriate correction (see MPEP 1205.03) within **ONE MONTH or THIRTY DAYS** from the mailing date of this Notification, whichever is longer.

**EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136.**

1. ☐ The brief does not contain the items required under 37 CFR 41.37(c), or the items are not under the proper heading or in the proper order.
2. ☐ The brief does not contain a statement of the status of all claims, (e.g., rejected, allowed, withdrawn, objected to, canceled), or does not identify the appealed claims (37 CFR 41.37(c)(1)(iii)).
3. ☐ At least one amendment has been filed subsequent to the final rejection, and the brief does not contain a statement of the status of each such amendment (37 CFR 41.37(c)(1)(iv)).
4. ☐ (a) The brief does not contain a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number and to the drawings, if any, by reference characters; and/or (b) the brief fails to: (1) identify, for each independent claim involved in the appeal and for each dependent claim argued separately, every means plus function and step plus function under 35 U.S.C. 112, sixth paragraph, and/or (2) set forth the structure, material, or acts described in the specification as corresponding to each claimed function with reference to the specification by page and line number, and to the drawings, if any, by reference characters (37 CFR 41.37(c)(1)(v)).
5. ☒ The brief does not contain a concise statement of each ground of rejection presented for review (37 CFR 41.37(c)(1)(vi)).
6. ☐ The brief does not present an argument under a separate heading for each ground of rejection on appeal (37 CFR 41.37(c)(1)(vii)).
7. ☐ The brief does not contain a correct copy of the appealed claims as an appendix thereto (37 CFR 41.37(c)(1)(viii)).
8. ☐ The brief does not contain copies of the evidence submitted under 37 CFR 1.130, 1.131, or 1.132 or of any other evidence entered by the examiner **and relied upon by appellant in the appeal**, along with a statement setting forth where in the record that evidence was entered by the examiner, as an appendix thereto (37 CFR 41.37(c)(1)(ix)).
9. ☐ The brief does not contain copies of the decisions rendered by a court or the Board in the proceeding identified in the Related Appeals and Interferences section of the brief as an appendix thereto (37 CFR 41.37(c)(1)(x)).
10. ☒ Other (including any explanation in support of the above items):

See Continuation Sheet.

/Jeff Piziali/  
Primary Examiner, Art Unit 2629

Continuation of 10. Other (including any explanation in support of the above items):

The Appellant is thanked for the Appeal Brief filed 3 September 2008. However, a non-compliant matter has been discovered in the aforementioned response, requiring attention before examination may continue.

37 C.F.R. § 41.37(c)(1)(vi) requires the 'Grounds of rejection to be reviewed on appeal' section of the brief must contain, "A concise statement of each ground of rejection presented for review."

MPEP 1205.02 further requires, "A concise statement of each ground of rejection presented for review. For example, the statement 'Whether claims 1 and 2 are unpatentable' would not comply with the rule, while the statements 'Whether claims 1 and 2 are unpatentable under 35 U.S.C. 103 over Smith in view of Jones,' and 'Whether claims 1 and 2 are unpatentable under 35 U.S.C. 112, first paragraph, as being based on a nonenabling disclosure' would comply with the rule. The statement cannot include any argument concerning the merits of the ground of rejection presented for review. Arguments should be included in the 'Argument' section of the brief."

The Appeal Brief filed 3 September 2008 improperly neglects to provide a concise statement of each ground of rejection presented for review (e.g., see at least Page 8 of the Appeal Brief filed 3 September 2008):

The 'Grounds of rejection to be reviewed on appeal' section of the brief neglects to address paragraph 57 of the Office action (mailed 28 May 2008), rejecting claims 67-70 under 35 U.S.C. 103(a) as being unpatentable over Hirai (US 5,440,304 A).

The Appellant is respectfully encouraged to provide a concise statement of each ground of rejection presented for review, as required by 37 C.F.R. § 41.37.

By such reasoning, this Notification of Non-Compliant Appeal Brief is deemed necessary and proper at this time.

Please note: The Appeal Brief has not been checked to the extent necessary to determine the presence of all possible non-compliance errors. If additional issues of non-compliance are discovered at the time of a subsequent Appeal Brief, yet another Notification of Non-Compliant Appeal Brief will be necessitated. Appellant's cooperation is requested in correcting any other errors of which Appellant may become aware.

/Jeff Piziali/  
Primary Examiner, Art Unit 2629  
17 November 2008